

Dominant features and trademark protection

April 18 2016 | Contributed by [Vellani & Vellani](#)

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Introduction

A civil petition for leave to appeal was filed in the Supreme Court by Farooq Ghee and Oils Mills (Private) Limited against decisions by the High Court of Sindh at Karachi. The respondents were the Registrar of Trademarks, the Trademark Registry and the International Foodstuff Company of UAE (IFFCO), among others.

The Supreme Court decision was based on the following observations:

- A trademark may comprise or be a combination of common words or invented words coupled with numerals, a device, a picture or any other type of image. Certain marks have one or more prominent feature clearly distinguishing the goods of one proprietor from its competitors, known as a 'dominant feature';
- Adding a prefix or suffix to an existing trademark or the dominant feature of an existing trademark (in an inconspicuous manner) is not enough to prevent a trademark registration being refused; and
- There is a growing tendency to misappropriate trademark rights by seeking protection under copyright law.

Facts

The dispute involved Farooq Ghee's FAROOQ'S HAYAT mark and IFFCO's HAYAT mark. Farooq Ghee applied to register the mark FAROOQ'S HAYAT (with HAYAT as the dominant feature) in Class 29 for "banaspati ghee, cooking oil, soybean oil, sunflower oil, edible oil, palm oil, canola oil, margarine, [and] fats" on August 24 2002.

The application was opposed by IFFCO, which had filed two trademark applications for the mark HAYAT in Class 29 for "edible oils and fat; ghee; [and] margarine" on April 11 1997 (prior filed) and August 1 2005.

Farooq Ghee also opposed IFFCO's applications. The Registrar of Trademarks ruled on the oppositions in favour of IFFCO based on the following:

- IFFCO had applied to register the HAYAT trademark on April 11 1997 in Pakistan and had used the mark in the Middle East and various other countries since 1990 and in Pakistan since 1996;
- IFFCO's evidence convinced the registrar that it was the originator, proponent and prior user of the HAYAT trademark in various countries; and
- Farooq Ghee adopted the competing mark FAROOQ'S HAYAT and applied for its registration on August 24 2002, more than a decade after IFFCO had adopted the HAYAT trademark.

The registrar dismissed Farooq Ghee's oppositions and allowed IFFCO's. As a result, IFFCO's applications for the mark HAYAT were allowed to proceed to registration and Farooq Ghee's

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application for FAROOQ'S HAYAT was refused. Farooq Ghee's subsequent appeals against the decisions at the High Court of Sindh at Karachi were also dismissed.

As a result, Farooq Ghee filed civil petitions for leave to appeal before the Supreme Court against the Registrar of Trademarks and High Court decisions, arguing that:

- the marks FAROOQ'S HAYAT and HAYAT were distinct and there was no likelihood of deception and confusion, and that the addition of the trading name FAROOQ's to the HAYAT mark distinguished the petitioner's goods from IFFCO's;
- its arguments were not substantiated from the record;
- a trademark search revealed no registered mark other than two pending applications for different goods and a market search revealed that similar products were unavailable; and
- it held a copyright registration for FAROOQ'S HAYAT under the Copyright Ordinance 1962.

Decision

The Supreme Court dismissed the petitions and held that the Registrar of Trademarks had correctly dismissed the registration of the FAROOQ'S HAYAT mark. The decision was based on the following observations:

- The petitioner was aware of IFFCO's use of the HAYAT trademark, since the official search report issued by the Trademarks Registry disclosed the trademark application filed for the mark.
- The trademark HAYAT was the dominant feature that IFFCO adopted internationally in 1990 and in Pakistan in 1996, and as such was associated with IFFCO.
- The FAROOQ'S HAYAT mark included the same dominating feature as IFFCO's trademark (ie, HAYAT), which was exclusively associated with IFFCO on account of prior adoption and use.
- In adding the prefix 'FAROOQ'S' in an inconspicuous manner (ie, a smaller font size) to the dominant feature, HAYAT did not alter the dominating mark enough to distinguish Farooq Ghee's goods from those of IFFCO. In this context the court noted that "if the petitioner's competing trademark is allowed registration, it would not only encourage unscrupulous traders to steal someone else's goodwill and (intellectual) property, but at the same time unwary purchasers would be exposed to more than reasonable probabilities of confusion and deception".
- The court held that Farooq Ghee's argument regarding copyright registration was misleading. The copyright registration of an artistic work under the name FAROOQ'S HAYAT was made on April 12 2004, following IFFCO's adoption, use and application for registration of the HAYAT trademark. Further, the court noted that copyright registration does not cover the registration of a title, brand, name or mark, except for the expression, style or getup of a work.
- The court observed that there is a growing tendency to misappropriate IP rights by seeking protection under a statute governing different IP rights. Copyright aims to protect original works of art or creative expression, while trademarks are associated with goods in order to indicate a connection between them and the proprietor in the course of trade. The practice of using copyright as a substitute for a trademark has been criticised by the courts in Pakistan in many instances and the defence of trademark infringement resting on copyright registration has been sternly rejected in a number of cases.

Comment

The Supreme Court decision highlights the proactive approach that the judiciary in Pakistan has adopted towards protecting IP rights in trademarks.

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